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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,445	10/19/2001	Sidney Dosh JR.	DOSHSMITH-01	1082
29633	7590	04/06/2006	EXAMINER	
ROGERS TOWERS, P.A. 1301 RIVERPLACE BOULEVARD, SUITE 1500 JACKSONVILLE, FL 32207			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,445

Applicant(s)

DOSH ET AL.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the first sentence of the specification, applicant claims priority to October 19, 2000. This is not consistent with Patent Office records, which shows the priority as actually being October 20, 2000. Appropriate correction is required.

Claim Objections

2. **Claims 3, 5-11, and 14-18 are objected to because of the following informalities:** Applicant uses lettering to order the method steps and system structure. However, claim 3 contains step (I), and since this claim depends from claim 1, there are no (G) and (H) steps. All of the above listed claims have similar problems. Appropriate correction is required.
3. **Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.** Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 7 depends from claim 6, yet they both appear to be the same step.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 10, 11, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** These claims recite the limitation "other system accounting". It is unclear as to what is required by "other" information.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2, 5-13, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawan (U.S. Patent No. 6,889,198).** Kawan teaches a multiple merchant smart card loyalty program that includes all of the limitations recited in the above claims.

Regarding claims 1, 10-12, and 18, Kawan teaches the enrolling of individual members (Column 5, Lines 55-61), the providing of smart cards capable of maintaining point balances (Column 5, Lines 50-52), the enrolling of merchants (multiple merchants shows that there must inherently be a step of enrolling) (Column 8, Lines 32-35), the

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providing of computer terminals capable of interacting with smart cards (Column 5, Lines 55-61), the providing of a loyalty bank computer server (Column 3, Lines 44-47), the crediting of points whenever a non-points purchase of goods is made (Column 3, Lines 59-62), and the debiting of points whenever points are redeemed (Column 4, Lines 1-9).

Regarding claims 2, 5, 13 and 15, Kawan teaches the recording and storing of member transactions in computer terminals (Column 16, Lines 20-24), and contacting of the loyalty bank computer server by the computer terminal to transfer the recorded transaction information (Column 12, Lines 65-67).

Regarding claims 6-9, 16, and 17, Kawan teaches the verifying of merchant information contained on the card (Column 6, Lines 46-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3, 4, 14, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,889,198) in view of Chien (U.S. Pub No. 2001/0054003).**

Regarding claim 3, 4, 14, 19, and 20, Kawan teaches the enrolling of individual members (Column 5, Lines 55-61), the providing of smart cards capable of maintaining

point balances (Column 5, Lines 50-52), the enrolling of merchants (multiple merchants shows that there must inherently be a step of enrolling) (Column 8, Lines 32-35), the providing of computer terminals capable of interacting with smart cards (Column 5, Lines 55-61), the providing of a loyalty bank computer server (Column 3, Lines 44-47), the crediting of points whenever a non-points purchase of goods is made (Column 3, Lines 59-62), the debiting of points whenever points are redeemed (Column 4, Lines 1-9), the recording and storing of member transactions in computer terminals (Column 16, Lines 20-24), and contacting of the loyalty bank computer server by the computer terminal to transfer the recorded transaction information (Column 12, Lines 65-67), and the verifying of merchant information contained on the card (Column 6, Lines 46-54). Kawan doesn't teach the providing of account information through a web server. Chien teaches a loyalty program which has a web page in which users can check account status online (Paragraph 0051). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to check account information online. This would give the user easier and quicker access to needed information.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to smart card loyalty programs:

U.S. Patent No. 6,594,640 to Postrel

U.S. Patent No. 6,549,912 to Chen


U.S. Pub No. 2002/0046116 to Hohle

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jeffrey D. Carlson
Primary Examiner